

**REMARKS**

At the outset, the Examiner is thanked for the thorough review and consideration of the pending application. The Office Action dated June 24, 2008 has been received and its contents carefully reviewed.

Claims 1, 4, 6, 7, and 9 are hereby amended. Support for the amendment can be found, for example, at Specification, page 13, lines 21-25. Claim 3 is canceled without prejudice or disclaimer. No new matter has been added. Accordingly, claims 1, 2, and 4-9 are currently pending. Reexamination and reconsideration of the pending claims are respectfully requested.

The Office Action rejects claims 1-9 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants have amended claims 1, 4, 6, 7 and 9, and canceled claim 3. Claims 1, 2, and 4-9 now more clearly define subject matter. Applicants, therefore, respectfully request withdrawal of the rejection.

The Office Action rejects claims 1-9 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office Action states “[Specification] 12:17-24 states that either an acid or base catalyst may be used [and t]his appears to contradict all other statements regarding the catalyst.” *Office Action*, page 3. Applicants respectfully traverse the rejection.

The present application describes many embodiments of the invention. Claims 1, 2 and 4-9 are directed to specific embodiments of the invention. There are no contracting statements regarding the catalyst. In fact, the Specification clearly states “it is desirable to use a base catalyst.” *Specification*, page 12, line 20. Accordingly, claims 1, 2 and 4-9 comply with the enablement requirement. Applicants, therefore, respectfully request withdrawal of the rejection.

The Office Action rejects claim 6 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office Action states “Claim 6 lacks the required base catalyst.” Applicants have amended claim 6. Claim 6 now depends from claim 1. As such, claim 6 complies with the enable requirement for the same reasons as claim 1. Applicants, therefore, respectfully request withdrawal of the rejection.

The Office Action rejects claims 1-2 and 5-9 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0055892 to Nishikawa et al. (*Nishikawa*). Applicants respectfully traverse the rejection.

As required in M.P.E.P. § 2131, in order to anticipate a claim under 35 U.S.C. § 102, “the reference must teach every element of the claim.” *Nishikawa* does not teach every element of claims 1-2 and 5-9, and thus cannot anticipate these claims.

Amended claim 1 recites, “wherein the hydrosilane compounds have the following Chemical Formula 1, or are oligomers manufactured from the silane compounds in the Chemical Formula 1 or cyclic siloxane compounds having the following Chemical Formula 2, and the weight average molecular weight of the resins is at least 5,000.” *Nishikawa* fails to teach at least these elements of claim 1. In fact, *Nishikawa* is completely silent with respect to weight average molecular weight. Accordingly, claim 1 is allowable over *Nishikawa*. Claims 2 and 5-9, which variously depend from claim 1, are also allowable for at least the same reasons as claim 1. Applicants, therefore, respectfully request withdrawal of the rejection.

The Office Action rejects claims 3-4 under 35 U.S.C. §103(a) as being obvious over *Nishikawa*. Claim 3 is canceled, so the rejection of claim 3 is moot. Applicants respectfully traverse the rejection of claim 4.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) *Nishikawa* fails to teach or suggest every element of claim 4, and thus, cannot render these claims obvious.

As discussed, *Nishikawa* fails to teach at least above-recited elements of claim 1, namely, “wherein the hydrosilane compounds have the following Chemical Formula 1, or are oligomers manufactured from the silane compounds in the Chemical Formula 1 or cyclic siloxane compounds having the following Chemical Formula 2, and the weight average molecular weight of the resins is at least 5,000.” Accordingly, claim 1 is allowable over *Nishikawa* under 35 U.S.C. §103(a). Claim 4, which indirectly depends from claim 1, is also

allowable for at least the same reasons as claim 1. Applicants, therefore, respectfully request withdrawal of the rejection.


The application is in condition for allowance and early, favorable action is respectfully solicited. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

Dated: September 26, 2008

Respectfully submitted,

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